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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No: 10/817,625 Confirmation No: 2819
Filing Date: 04/01/2004 Group Art Unit: 3711
Applicant: Joseph Hedrick Examiner:
Status (on 3/8/05): Application Dispatched from Pre-Exam, Not Yet Docketed
Title: GAMING MACHINE HAVING SECONDARY DISPLAY FOR
PROVIDING VIDEO CONTENT

ATTENTION: TECHNOLOGY CENTER DIRECTOR

PROTEST UNDER 37 C.F.R. 1.291

Mail Stop: REISSUE
Commissioner for Patents
PO BOX 1450
Alexandria, VA 22313-1450

Dear Sir:

The undersigned attorney, as a member of the public and pursuant to 37 CFR 1.291, hereby protests the Application No. 10/817,625 for the broadening reissue of U.S. Patent No. 6,368,216 on the grounds that it fails to comply with the statutory requirements for patentability and reissue of defective patents.

I. **LIST OF INFORMATION RELIED UPON AND CONCISE
EXPLANATION OF RELEVANCE**

1. 35 U.S.C. §251
 - Cites the statutory prohibition against introduction of new matter in a reissue application.
2. 35 U.S.C. §112
 - First paragraph cites the statutory requirement that the specification contain a written description of the invention sufficient to enable any person skilled in the art to make and use it.
3. *In re Amos*, 953 F.2d 613, 21 USPQ 2d 1271 (Fed. Cir. 1991)
 - Federal Circuit opinion providing guidelines for the written description, enablement and ‘same invention’ inquiries in reissue cases as required by 35 U.S.C. §112, first paragraph and 35 U.S.C. §251.
4. Form PTO-1449
 - U.S. Patent No. 5,902,983 – referenced in the ‘216 patent specification as USSN 08/639,762.
5. MPEP 602 §V
 - Establishes the Office requirement that a Supplemental oath or declaration be required if the prior oath or declaration improperly refers to an amendment containing new matter.

II. PROTEST COUNTS

1. Reissue Claims 26 and 28-62 should be rejected under 35 U.S.C. §251 as being based on new matter added to the patent for which reissue is sought.
2. The specification should be rejected under 35 U.S.C. §112, first paragraph, as failing to provide an adequate written description of the claimed invention.
3. A Supplemental oath or declaration should be required under 37 C.F.R. 1.67(b) because the prior Declaration improperly refers to an amendment containing new matter.

III. DETAILED REMARKS

Background

- USSN 10/817,625 seeks to reissue U.S. Patent No. 6,368,216 (the ‘216 patent).
- USSN 10/817,625 was filed on April 1, 2004 together with a Preliminary Amendment amending prior Claims 4 and 26, and adding new Claims 28-62.
- This is a broadening reissue. (See Reissue Declaration, Paragraph 5.)

Count 1: New Matter

The ‘216 patent discloses a gaming machine having a Main Display 220 for presenting primary game play and outcome information, and a Secondary Display 219, which is a video display, for displaying secondary information. It further discloses a Player Tracking Display 313, 518 associated with a player tracking device for displaying alpha-numeric messages associated with the player tracking function. (See Col. 7:11-13

and Col. 9:23-33). A significant portion of the technical description in the '216 patent is devoted to the operation of these 3 different displays (i.e., the Main Display 220, the Secondary Display 219, and the Player Tracking Display 313, 518).

The '216 patent describes that alpha-numeric content from the Player Tracking Display 518 may be provided on the Main Display 220 or the Secondary Display 219 (Col. 9:33-35). However, the reverse is not taught. In other words, the '216 patent fails to disclose or suggest that video content from the Secondary Display 219 can be provided on the Player Tracking Display 313, 518. In fact, the '216 patent fails to teach displaying or providing any video on the Player Tracking Display 313, 518.

In the subject reissue application, newly presented independent Claims 26, 39 and 49 teach that video content from the Secondary Display 219 can be provided on or within the player tracking system. Thus, Claims 26, 39 and 49 introduce new matter into the '216 patent for which reissue is being sought.

To be specific, Claims 26 and 49 are directed toward a gaming machine including a player tracking system. In each of these new claims, the player tracking system comprises "a secondary display". However, in the original '216 patent, the Secondary Display 219 is not part of the player tracking system – instead, it is a feature of the gaming system. (See Col. 8:50-55.) The statement that the player tracking system comprises the secondary display is new matter in the reissue application.

Claim 39 is directed toward a player tracking system *per se*. In Claim 39, the player tracking system includes "a display operable to display video content." Conversely, the '216 patent teaches only that the Player Tracking Display 313, 518 presents alpha-numeric information. (See Col. 7:11-13; see also Col. 9:23-33.) As

disclosed in the '216 patent, video content is presented only by the Main Display 220 and the Secondary Display 219; never on the Player Tracking Display 313, 518. Thus, USSN 10/817,625 here also introduces new matter in the reissue application because it describes the Player Tracking Display 313, 518 as "operable to display video content."

The '216 patent does not teach or suggest that video content (from the Secondary Display 219 or otherwise) can be presented on the Player Tracking Display 313, 518. Claims 26, 39 and 49 thus introduce new matter into the '216 patent for which reissue is sought. Such is prohibited under 35 U.S.C. §251, and therefore Claims 26 and 28-62 should be rejected.

Count 2: Insufficient Written Description

MPEP 1411.02 directs that a rejection under 35 U.S.C. §112, first paragraph, should be made if new matter is added to the claims. (See Examiners Note.) For the reasons described above, new matter has been added to reissue Claims 26, 39 and 49. Thus, a rejection of the specification under 35 U.S.C. §112, first paragraph, is warranted.

The written description (in this case, the disclosure originally filed) must describe the claimed invention and 'enable' the subject matter claimed to those skilled in the art.

On reissue cases like this one, the §112 written description and enablement inquiries are analogous to the 'same invention' test under 35 U.S.C. §251. *In Re Amos*, 953 F.2d 613, 618, 21 USPQ 2d 1271, 1274 (Fed. Cir. 1991). See also MPEP 1412.01 which makes clear that claims presented in a reissue application are considered to satisfy the 'same invention' requirement when they are described in the original patent specification and enabled by the original patent specification.

Thus, to support claims presented in the reissue application, the original patent disclosure must provide both description and enablement of the newly claimed invention. However, the '216 patent does not disclose the new functionality attributed to the Player Tracking Display 313, 518 features in Claims 26, 39 and 49. Specifically, new Claims 26, 39 and 49 contain the following features which are not disclosed or enabled in the '216 patent:

- 1) That the Secondary Display (219) sends video content to the Player Tracking Display (313, 518);
- 2) That the Secondary Display (219) is part of the Player Tracking System; and
- 3) That the Player Tracking Display (313, 518) is operable to display video content.

Applicant's original patent disclosure, as well as its "incorporated by reference" citation of USSN 08/639,762 at Col. 6:30-37 (now U.S. 5,902,983) suggest only that alpha-numeric displays from the player tracking system can be provided to the Main Display 220 or the Secondary Display 219. (See Col. 9:33-35 of the '216 patent). The reverse of this, i.e., that the Secondary Display 219 can send video content to the Player Tracking Display 313, 518, is not disclosed or suggested. USSN 10/817,625 is attempting to claim the reverse of what is taught in the original application.

Therefore, there is not an enabling disclosure for, and no basis upon which to form a belief that the inventors of the '216 patent had possession of, the new Claims 26, 39 and 49 at the time of the original filing. Accordingly, the reissue specification should be rejected under 35 U.S.C. §112, first paragraph.

Count 3: Supplemental Oath Required

If the oath or declaration improperly refers to an amendment containing new matter, a supplemental oath or declaration will be required pursuant to 37 C.F.R. §1.67(b), deleting the reference to the amendment containing new matter. (See MPEP 602 §V.)

As demonstrated above, the reissue application contains new matter in that claims 26, 39 and 49 introduce functionality into the Player Tracking Display 313, 518 which was not described or enabled within the original '216 patent. The reissue Declaration refers to the Preliminary Amendment containing new matter. (See Reissue Declaration, Paragraph 2.) Therefore, the reissue Declaration submitted at the filing of this reissue application is defective, and a Supplemental oath or declaration is required (MPEP §603).

Oaths or declarations in Broadening reissues are held to a high standard. Unlike narrowing reissues, the oath or declaration in a broadening reissue application must be made and sworn to by the actual inventors. (35 U.S.C. §251, third paragraph.) Thus, a defective oath or declaration must not be tolerated – especially in a broadening reissue application such as this USSN 10/817,625. As the subject broadening reissue application was filed with a defective Declaration (by improperly referring to the Preliminary Amendment which contained new matter), the Office should require a Supplemental oath and declaration after the new matter is cancelled from Claims 26, 39 and 49.

Accordingly, the reissue application should be rejected on the basis of a defective oath or declaration pursuant to 37 C.F.R. §1.175.

IV. CONCLUSIONS AND RECOMMENDATIONS

The undersigned attorney hereby protests the reissue of U.S. Patent No. 6,368,216 via Application No. 10/817,625 for the following reasons:


1. Reissue claims 26, 39 and 49 are based on new matter added to the patent for which reissue is sought in violation of 35 U.S.C. §251.
2. The specification fails to provide a written description of the invention, in that no support is provided for limitations presented in new Claims 26, 39 and 49, thereby violating 35 U.S.C. §112, first paragraph.
3. The Declaration filed with the reissue application is defective because it improperly refers to an amendment containing new matter, in violation of 37 C.F.R. 1.175 and MPEP §602.

Wherefore, the undersigned attorney respectfully requests the U.S. Patent Office reject and refuse Application No. 10/817,625. In the alternative, the Office should require a Supplemental oath or declaration together with cancellation of the new matter contained in Claims 26 and 28-62.

V. SERVICE OF PAPERS

The undersigned attorney has complied with 37 C.F.R. §1.248 and has served a full and complete copy of this Protest on the attorney for the applicants of USSN 10/817,625 via the manner and on the date set forth in the accompanying Proof of Service.

Respectfully Submitted,


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Proof of Service Under 37 C.F.R. 1.248

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient Postage as first class mail in an envelope addressed to:

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on Mar. 9, 2005



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